UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,176	08/21/2003	Anmol N. Matada	AUS920030385US1	7301

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EXAMINER
WALSH, DANIEL I

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/645,176	MATADA, ANMOL N.
	Examiner	Art Unit
	Daniel I Walsh	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
   since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
   37 CFR 1.78.

   a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
   reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>08-03</u> .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Specification

1.   The disclosure is objected to because of the following informalities:

Re page 1, line 1: Replace "Application...filed contemporaneously" with -- Application

No. 10/645,199 filed contemporaneously --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jaros et al. (WO

02/35435), as cited by the Applicant.

Re claim 1, Jaros et al. teaches entering using application information into a local

computer (remote dispensers 110/120/TOPS 121/TOPS 131/ FIG. 9), transmitting the user

application information from the local computer to a host server , receiving new bank card

information from the host server at the local computer in response to the transmitting step and

creating a new bank card having the new bank card account information encoded thereon in

machine readable form immediately after the receiving step (FIG. 1 and FIG. 10).

Re claim 2, Jaros et al. teaches the use of the Internet to decide on card issuing

(transmitting step) (page 6, lines 23+ and FIG. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 3-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaros et al.

The teachings of Jaros et al. have been discussed above. Jaros et al. teaches taht the

credit card processing module 252 and FIG. 2, 5, 6 may analyze the information contained in the

submitted application in view of the credit models 254 to arrive at a decision (page 9, lines 4+

and page 12, lines 21+). Jaros et al. teaches liking with the credit bureau to authorize a credit

card (page 9, lines 10+). This is interpreted to include communicating with a third party

company to apply for a bankcard account on behalf of a user. Though Jaros et al. teaches

communicating, but not specifically transmitting the information to the credit bureau, and that

the credit bureau has a user profile, it is well known and conventional that credit bureaus contain

profiles for individuals. Further, in light of Jaros et al. teaching communicating with the credit

bureau, it would have been obvious to transmit application data to the credit bureau as an

obvious expedient to verify/reject a customer for a credit card they are applying for, especially

since Jaros et al. teaches communicating with the credit bureau with a communications link.

Accessing the resources of the credit bureau by downloading information or transmitting it,

would be an obvious expedient.

Re claim 4, Jaros et al. teaches card information 259 stored on the secondary storage

device that is outside the local computer. Though Jaros et al. teaches the remote dispenser 110

includes a memory 132 including a remote dispensing module 133 which receives an embossing

record to emboss a card (interpreted to include account information), Jaros et al. is silent to

storing such data in a database. However, at the time the invention was made, it would have

been obvious to an artisan of ordinary skill in the art to store such records locally, as is well

known and conventional in the art, for record keeping purposes, in a well known format, such as

a database.

Re claims 5-6, Jaros et al. teaches that the remote dispensing module interacts with the

instant issuance module and embossing machine 138 to receive an embossing record, send it to

the embossing machine, the embossing and writing the encoded information to the card's

magnetic strip (page 10, lines 3+). Jaros et al. teaches that the embossing machine is separate

from the comptuer (page 12, lines 1+), which therefore teaches sending information from the

local computer to an access device. Though Jaros et al. teaches that the memory 132 include a

remote dispensing module 133 that receives the embossing record, Jaros et al. is silent to the

information being downloaded. However, at the time the invention was made, it would have

been obvious to download the information in order to have a record, as is well known and

conventional in the art for security/record/tracking purposes.

Re claim 7, it is interpreted by the Examiner that as the credit card access device receives

the embossing record (as per claims 5-6 above) that the access device uses the record to create

the card, and therefore, the local comptuer can be interpreted as programming the device as it

sends instructions that the access device follows.

Re claim 8, Jaros et al. teaches a display for output 150, a keyboard for input 152, a

network communication device (FIG. 1), a processor connected to the display, keyboard, and

network communication device, the processor executing instruction which allow the user to enter

application information, transmit the user application information to a host server using the

network communications device, receiving new bank card account information from the server,

and immediately receive the new bank card account information to a credit card access device

(FIG. 8, FIG. 1, page 10, lines 3+, and FIG. 10). Though Jaros et al. teaches that the dispensing

module receives the embossing record, Jaros et al. is silent to downloading it. However, at the

time the invention was made, it would have been obvious to an artisan of ordinary skill in the art

to download the record since it is well known to keep such electronic records for tracking/record

keeping purposes, and therefore is an obvious expedient. Further, it is well known and

conventional that computer systems include permanent and temporary memory, and that CPUs

are connected to the memories. Permanent storage means such as system programs are well

known and conventional in the art and are accessed by the processor as is conventional in the art.

Re claim 9, Jaros et al. teaches transmitting user application information to a host server

(page 6, lines 23+ and FIG. 1).

Re claim 10, though Jaros et al. teaches encrypting techniques to user to ensure secure

communication of data and industry requirements, as is well known and conventional in the art

(page 5, lines 12+).

Re claims 11-12, Jaros et al. teaches that an application is submitted at the computer by a

customer completing the application in a manner as is known in the art (FIG. 10), such as

through an interface or keyboard/display, for example. Though Jaros et al. teaches completing

and submitting an application at the computer, Jaros et al. is silent to a computer database storing

information for multiple bank card accounts, including the new bank card account information,

and manually entering such information into the database. However, at the time the invention

was made, it was well known and conventional in the art for a persons credit history, including

credit cards, debts, employment history, etc. to be evaluated to establish a individuals level of

risk, when applying for a credit card, cash advance, loan, etc. Accordingly, it would have been

obvious to provide manual input means of previous account information, along with other

personal information (as the input of personal information is taught by Jaros et al.), to establish a

risk assessment for a user applying for a credit card, especially since Jaros et al. teaches

contacting a credit bureau for credit assessment purposes, thereby illustrating the importance of

determining a type of offer to give a customer (page 12, lines 25+). Being entered at the

computer itself, it would be obvious to store such data locally and manually, in a database for

example, for record keeping purposes, along with the bank card application of the card being

applied for (new bank card account) for record keeping purposes.

Re claim 13, it is well known that programs interface with each other in a computer

system. Jaros et al. teaches credit card management means (page 10, lines 18+) including

reconciling the number of credit cards dispensed with the number of records created. Though

Jaros et al. is silent to programs interfacing with each other, it is understood that programs

interface with each other in such systems as is conventional in the art.

Re claim 14, it is understood that through the system and its program instructions,

interpreted as the instructions that govern the operation of the system, that they program the

credit card access device through the local computer, as taught above re claim 7; the embossing

record sent by the comptuer program instructions programs the access device.

Re claim 15, Jaros et al. teaches a card substrate with a machine readable medium (page 13, lines 14+), a credit card access device (138) which writes selected bank card account information to the readable/writable medium of the card substrate, subject to user authentication (page 13, lines 3+) , and a computer having program instructions which allow a user to enter application information (FIG. 10), transmitting the user application information to a host server using the network communications device (FIG. 1), receiving new bank card account information from the host server (remote dispensing module 133), and immediately send the new bank card account information to the credit card access device (FIG. 10, where the card is created and dispensed). Though Jaros et al. teaches that the dispensing module receives the embossing record, Jaros et al. is silent to downloading it. However, at the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to download the record since it is well known to keep such electronic records for tracking/record keeping purposes, and therefore is an obvious expedient.

Re claim 16, Jaros et al. teaches the application is sent to the server across the Internet (transmitting step) (page 6, lines 23+ and FIG. 1).

Re claim 17, though Jaros et al. teaches encrypting techniques to user to ensure secure communication of data and industry requirements, as is well known and conventional in the art (page 5, lines 12+).

Re claims 18-19, Jaros et al. teaches that an application is submitted at the computer by a customer completing the application in a manner as is known in the art (FIG. 10), such as through an interface or keyboard/display, for example. Though Jaros et al. teaches completing and submitting an application at the computer, Jaros et al. is silent to a computer database storing

information for multiple bank card accounts, including the new bank card account information, and manually entering such information into the database. However, at the time the invention was made, it was well known and conventional in the art for a persons credit history, including credit cards, debts, employment history, etc. to be evaluated to establish a individuals level of risk, when applying for a credit card, cash advance, loan, etc. Accordingly, it would have been obvious to provide manual input means of previous account information, along with other personal information (as the input of personal information is taught by Jaros et al.), to establish a risk assessment for a user applying for a credit card, especially since Jaros et al. teaches contacting a credit bureau for credit assessment purposes, thereby illustrating the importance of determining a type of offer to give a customer (page 12, lines 25+). Being entered at the computer itself, it would be obvious to store such data locally and manually, in a database for example, for record keeping purposes, along with the bank card application of the card being applied for (new bank card account) for record keeping purposes.

Re claim 20, Jaros et al. teaches credit card management means (page 10, lines 18+) including reconciling the number of credit cards dispensed with the number of records created. Though Jaros et al. is silent to programs interfacing with each other, it is understood that programs interface with each other in such systems as is conventional in the art.

Re claim 21, it is understood that through the system and its program instructions, interpreted as the instructions that govern the operation of the system, that they program the credit card access device through the local computer, as taught above re claim 7; the embossing record sent by the comptuer program instructions programs the access device.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Maes et al. (US 6,016,476)Masuda (US 5,569,987), Natsuno (US 2003/0045328),

Ohta et al. (US 2002/0088852), and Sakashita et al. (US 2002/0030099).

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Daniel Walsh whose telephone number is (703) 305-1001 or

(571) 272-2409 (as of January 15, 2004). The examiner can normally be reached between the

hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Michael G. Lee can be reached on (703) 305-3503 or (571) 272-2398 (as of January

15, 2004). The fax phone numbers for this Group is (703) 872-9306, (703) 308-7724, or (703)

308-7382.

Communications via Internet e-mail regarding this application, other than those under 35

US.C. 132 or which otherwise require a signature, may be used by the applicant and should be

addressed to **[daniel.walsh@uspto.gov]**.

> All Internet e-mail communications will be made of record in the application file. PTO
> employees do not engage in Internet communications where there exists a possibility that
> sensitive information could be identified or exchanged unless the record includes a properly
> signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more
> clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the
> Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the Group receptionist whose telephone number is (703) 308-0956.

DW
1/9/04

KARL D. FRECH
PRIMARY EXAMINER